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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,490	04/28/2000	TOSHIO MIYAMOTO	H-914	1985

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EXAMINER

GRAYBILL, DAVID E

ART UNIT PAPER NUMBER

2827

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,490

Applicant(s)

MIYAMOTO ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 34-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive because the claims in the new continuing application were not drawn to the same invention as the claims in the old application, therefore, the finality of that action is withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Akagawa (5834844) and Iwasaki (5892273).

At column 3, line 52 to column 4, line 12; and column 8, line 41 to column 10, line 49, Akagawa teaches the following:

34. A chip scale package, provided by dividing a semiconductor wafer along scribe lines defining a plurality of chip scale package forming areas in said semiconductor wafer, comprising:

(a) a semiconductor chip 32 having a main surface, a rear surface opposite to said main surface and a surface passivation film 34 to cover said main surface, said semiconductor chip having a plurality of semiconductor elements and bonding pads 36 formed on said main surface thereof, said bonding pads being exposed from said surface passivation film;

(b) an elastomer layer of a polyimide film 38 formed on said surface passivation film to cover said main surface of said semiconductor chip and to expose said bonding pads, said elastomer layer having an elastic modulus relatively lower than said surface passivation film;

(c) conductive layers 40, 40a, 41 formed on said elastomer layer, first ends 4a of said conductive layers being disposed on said elastomer layer and second ends 41 of said conductive

layers being electrically connected to the corresponding ones of said bonding pads; and

(d) a plurality of bump electrodes 46 formed on said elastomer layer, said plurality of bump electrodes being electrically connected to said first ends of said conductive layers.

35. A chip scale package according to 34, wherein said bump electrodes are solder bump electrodes.

36. A chip scale package according to 34, wherein said elastomer layer has an elastic modulus of about 1 to 500 Mpa.

37. A chip scale package according to 34, wherein said conductive layers are formed by plating.

However, Akagawa does not appear to explicitly teach that the passivation film is a silicon nitride film.

Nevertheless, at column 7, lines 9-12, Iwasaki teaches a silicon nitride passivation film 13. Moreover, because Akagawa teaches a silicon oxide passivation film and Iwasaki teaches that silicon oxide and silicon nitride passivation films are functional equivalents, it would have been obvious to combine the product of Iwasaki with the product of Akagawa.

To further clarify the teachings of the plurality of chip forming areas having a plurality of semiconductor elements, the elastomer layer having an elastic modulus relatively lower than the surface passivation film, and wherein the elastomer layer

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has an elastic modulus of about 1 to 500 Mpa, it is noted that these limitations are inherent properties of the product of the applied prior art.

In any case, as cited, Akagawa teaches that "elasticity" of the elastomer film is a result-effective variable; with a "rubber-like elasticity" being particularly desirable. Therefore, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose the particular claimed elastic modulus limitations because applicant has not disclosed that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical, and it appears prima facie that the product would possess utility using another elastic modulus. Indeed, it has been held that optimization of range limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See MPEP 2144.05(II): "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. '[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to

discover the optimum or workable ranges by routine experimentation.'" In re Aller, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). See also In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989), and In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990). As set forth in MPEP 2144.05(III), "Applicant can rebut a prima facie case of obviousness based on overlapping ranges by showing the criticality of the claimed range. 'The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.' In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results."

Applicant's remarks filed 11-25-2 have been fully considered and are addressed infra.

In response to applicant's argument that applicant has a different reason for, or advantage resulting from, doing what the applied prior art has suggested, it is noted that this is

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not demonstrative of nonobviousness. In re Kronig 190 USPQ 425, 428 (CCPA 1976); In re Lintner 173 USPQ 560 (CCPA 1972); indeed, the prior art motivation or advantage may be different than that of applicant while still supporting a conclusion of obviousness. In re Wiseman 201 USPQ 658 (CCPA 1979); Ex Parte Obiaya 227 USPQ 58 (Bd. of App. 1985).

Also, applicant requests withdrawal of the finality of the previous Office action because, "a request for an interview prior to first action on a continuing or substitute application should ordinarily be granted. This was not done."

It is respectfully submitted that this is not proper grounds for request for withdrawal of the finality of an Office action because, pursuant to MPEP 706.07(b), an interview prior to first action on a continuing or substitute application is not mandatory, and, pursuant to MPEP 408, requests for telephone calls and reasons why proposed telephone interviews would not be considered effective to advance prosecution need not be noted or acknowledged.

408 Telephoning Attorney

Present Office policy places great emphasis on telephone interviews initiated by the examiner. For this reason, it is not necessary for an attorney to request a telephone interview. Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interviews would not be considered effective to advance prosecution. However, it is desirable for an attorney to call the examiner if the attorney feels the call will be beneficial to advance prosecution of the application. See MPEP § 713.01 and § 713.05.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-308-1782306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/308-7722.

David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
7-Mar-03